

Appl. No. 10/824,118
Docket No. 9209M
Amdt. dated August 23, 2010
Reply to Office Action mailed on April 23, 2010
Customer No. 27752

REMARKS

Claim Status

Claims 25-36 are pending. Claims 1-24 were previously canceled. No additional claims fee is believed to be due.

Claim 1 is currently amended to narrow the claim scope to a more preferred embodiment. It is believed this change does not involve any introduction of new matter. Consequently, entry of this change is believed to be in order and is respectfully requested.

Rejection under 35 USC §103(a) over Drechsler in view of Gawtrety and Nanba

Claims 25-36 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Drechsler *et al.*, U.S. Pat. No. 6,139,823 (hereinafter “Drechsler”) in view of Gawtrety, U.S. Pat. App. Pub. No. 2003/0157049 (hereinafter “Gawtrety”) and Nanba *et al.*, European Pat. No. 0 829 254 (hereinafter “Nanba”). This rejection is respectfully traversed. First, Applicants respectfully submit that the Drechsler, Gawtrety, and Nanba references are improperly combined. Second, Applicants respectfully submit that the subject matter recited in the pending claims is not obvious over the combined disclosures of the applied prior art.

Applicants respectfully submit that an ordinarily skilled artisan, after reading the Drechsler, Gawtrety, and Nanba references, would not have the requisite motivation to create the composition Applicants claim. The § 103(a) rejections set forth in the action are a hindsight reconstruction of the prior art, impermissibly based on Applicants’ disclosure (and not on only the knowledge which was within the level of ordinary skill in the art at least as of the application’s effective filing date).¹

The asserted rationale supporting the § 103(a) rejections on this combination of prior art does not apply absent sound findings that the skilled artisan would have been

¹ See Board of Patent Appeals and Interferences decision on December 14, 2009 re: U.S. App. 11/135,244: “The Examiner has not established that one of ordinary skill in the art would have had a reason to coat silicone fibril-coated metal oxide particles with an additional hydrophobic coating, and to combine the coated particles with a cross-linked, non-emulsifying organopolysiloxane elastomer.”

motivated to combine the prior art to achieve the claimed invention.² Moreover, the mere fact that the applied prior art can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to the ordinarily skilled artisan.³ There is simply no reasonable expectation of predictably achieving success by simply reading the Drechsler, Gawtreys, and Nanba combination of references. The precise combination of prior art is hindsight reconstruction, impermissibly based on Applicants' disclosure. The Office provides no evidence that the hindsight reconstruction used to reject the claims here (a) takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and (b) does not include knowledge gleaned only from Applicants' disclosure. The Board of Patent Appeals and Interferences emphasized that examiners must still give strong reasons for their rejections.⁴

Not one of Drechsler, Gawtreys, or Nanba provide a person having ordinary skill in the art with the motivation to select particular elements from Drechsler (*e.g.*, organosiloxane resin, diorganopolysiloxane polymer, and volatile carrier) for combination with a particular element from Gawtreys or Nanba (*e.g.*, aminosilicone) to form a cosmetic composition, as opposed to combining numerous other ingredients disclosed in these references to form a hair care composition. The only disclosure combining the claimed features is Applicants' specification and claims.

The asserted rationale supporting the § 103(a) rejection on this combination of prior art does not apply absent sound findings that the skilled artisan would have been motivated to combine the prior art to achieve the claimed invention.⁵ Moreover, the mere

² See MPEP § 2143 (G).

³ See *KSR Int'l*, 127 S.Ct. at 1740.

⁴ See Board of Patent Appeals and Interferences decision on May 10, 2007 re: U.S. App. 09/757,913: "After carefully considering both the Chen and Maggenti references, we find no specific teaching or suggestion within either reference that fairly meets the language of the claim that requires 'stopping the context information updating. . . ,' and 'taking a snapshot of the compression and decompression context information . . . ' (claim 1). We find that to affirm the Examiner on this record would require speculation on our part. . . . Because we find the combination of Chen and Maggenti fails to teach or suggest all the limitations recited in the claim, we agree with Appellants that the Examiner has failed to meet the burden of presenting a prima facie case of obviousness. Accordingly, we will reverse the Examiner's rejection of independent claim 1 as being unpatentable over Chen in view of Maggenti."

⁵ See MPEP § 2143(G).

fact that the applied prior art can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to the ordinarily skilled artisan.⁶ There is simply no reasonable expectation of predictably achieving success by simply reading the Drechsler-Gawtrety-Nanba combination of references.

Assuming, *arguendo*, that the Drechsler and Gawtrety and Nanba references are properly combined, Applicants respectfully submit that the subject matter recited in the pending claims is not obvious over the combined Drechsler-Gawtrety-Nanba disclosures. The Office states that Drechsler does not teach mixtures comprising aminosilicones as separate components in addition to any other diorganopolysilicone. The Office relies on Gawtrety to teach this aspect of the present invention, yet Gawtrety relates only to hair-care compositions. Further, the Office relies on Nanba to teach combinations of aminosilicones and separate, distinct polyorganosiloxanes in cosmetic compositions.

Drechsler, in view of Gawtrety and Nanba, does not teach or suggest all of the limitations of Claims 25-36. The Drechsler-Gawtrety-Nanba combination does not teach or suggest a cosmetic composition comprising the aminosilicone, organosiloxane resin, and diorganopolysiloxane polymer which Applicants claim. Applicants' composition requires both diorganopolysiloxane and a specific aminosilicone—resulting in a blend of two differently functionalized silicones—whereas the Drechsler-Gawtrety-Nanba combination does not teach or suggest these two components together in the claimed cosmetic composition. Accordingly, Gawtrety and Nanba do not make up for the deficiencies of Drechsler.

Applicants respectfully submit that the Drechsler-Gawtrety-Nanba references are improperly combined, or, alternatively, the Drechsler-Gawtrety-Nanba combination does not render obvious Applicants' claimed subject matter. In view of the above, Applicants submit that Claim 25, and the claims depending therefrom, are patentably distinct from Drechsler in view of Gawtrety and Nanba and Applicants request withdrawal of the rejection. Accordingly, Applicants respectfully request reconsideration and withdrawal of the Section 103 rejection.

⁶ See *KSR Int'l*, 127 S.Ct. at 1740.


Appl. No. 10/824,118
Docket No. 9209M
Amdt. dated August 23, 2010
Reply to Office Action mailed on April 23, 2010
Customer No. 27752

Conclusion

Applicants have made an earnest effort to place the present application in proper form and to distinguish the invention as claimed from the applied references. In view of the foregoing, Applicants respectfully request entry of the amendments presented herein, reconsideration of this application, and allowance of the pending claims.

Respectfully submitted,

THE PROCTER & GAMBLE COMPANY



Megan C. Hymore
Registration No. 59,501
(513) 983-3279

Date: August 23, 2010
Customer No. 27752